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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

060623

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Application Number

10/589,961

Filed

08/18/2006

First Named Inventor

Yoshiaki Matsunami

Art Unit

1795

Examiner

APICELLA, Karie O.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 37,806

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Darren Crew
Signature

Darren Crew

Typed or printed name

202-659-2930

Telephone number

October 14, 2010

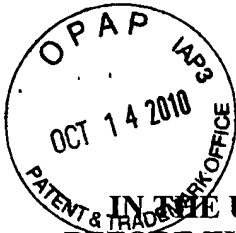
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of: **MATSUNAMI, Yoshiaki, et al.**

Group Art Unit: **1795**

Serial No.: **10/589,961**

Examiner: **APICELLA, Karie O.**

Filed: **August 18, 2006**

P.T.O. Confirmation No.: **1062**

For: **SEPARATOR FOR LEAD-ACID BATTERY**

REASONS FOR REQUEST

The Examiner has adopted a factually incorrect position. In particular, the Examiner has adopted the factually incorrect position that claim 1 includes product-by-process limitations.

The Examiner has improperly alleged that the claims of the subject application are product-by-process claims. In fact, the claims are **not** product-by-process claims.

After the Examiner improperly alleged that the claims are product-by-process claims, the Examiner proceeded to improperly neglect to give patentable weight to all features as set forth in the claims. In particular, the Examiner noted that “The so-called ‘physical characteristics’ are not given patentable weight due to the product-by process limitations” (Office Action dated April 15, 2010, page 9, lines 8-9).

The Examiner has suggested that “Applicant has not sufficiently shown burden of proof that the products of the instant invention and the prior art are not the same and would not produce the same physical characteristics. The instant invention and the prior art reference, Choi, utilize the same materials, which is a separator for a lead acid battery comprising a porous membrane made from a polyolefin resin, an inorganic powder and a mineral oil, as well as, containing a surface active agent” (Advisory Action dated September 24, 2010, page 2).

However, the burden has not shifted to the Applicants in this instance, because claim 1 does not set forth any product-by-process limitations.

The Examiner has taken the factually incorrect position that claim 1 includes product-by-process limitations. Claim 1 sets forth a combination of features including *inter alia* “A separator for a lead-free battery comprising: a porous membrane ... , **wherein the separator liberates or elutes 1.0 ml or less per 100 cm² of reducing substance**, as calculated from a

consumption of a 0.01 N potassium permanganate solution per 100 cm² of the porous membrane, **when four test pieces of the separator each having a height of 10 cm and a width of 10 cm are subjected to 24 hours of electrolysis carried out at about 25°C with a direct current of 1.2 A by using an electrolytic cell composed of the porous membrane, a positive electrode, a negative electrode and diluted sulfuric acid**” (emphasis added).

The language in claim 1 sets forth aspects of an end product. Claim 1 sets forth a combination of features of an end product. Claim 1 sets forth features and characteristics of the final product.

The language in claim 1 does not set forth a method of making an end product. Claim 1 does not set forth method steps. Claim 1 does not set forth process steps.

A careful reading of claim 1 clearly shows that claim 1 sets forth a combination of features corresponding to an end product. A close study of claim 1 clearly shows that claim 1 does not set forth any process steps associated with the making of that end product.

The claimed features are directed to an end product, which is a separator for a lead-acid battery, that releases only a limited amount of reducing substance (that is, 1.0 ml of less per 100 cm² as claimed) when the separator is subjected to certain test conditions. See the specification: p. 4, lines 11-15; p. 16, line 3, to p. 18, line 17. When four test pieces of an embodiment of a separator according to the claimed features were subjected to the claimed test condition (subjecting four separator test pieces to 24 hours of electrolysis carried out at about 25 C with a direct current of 1.2 A by using an electrolytic cell composed of the porous membrane, a positive electrode, a negative electrode and diluted sulfuric acid), the recited amount of reducing substance were liberated or eluted from the test pieces. This amount of reducing substance liberated or eluted is characteristic of the claimed separator, much like a melting point or a boiling point would be characteristic of a compound.

Choi and Tsuda, alone or in combination, fail to describe, teach or suggest the combination of features as set forth in claim 1, including at least the following features “wherein the separator liberates or elutes 1.0 ml or less per 100 cm² of reducing substance, as calculated from a consumption of a 0.01 N potassium permanganate solution per 100 cm² of the porous

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Pre-Appeal Brief Request for Review filed October 14, 2010

membrane, when four test pieces of the separator each having a height of 10 cm and a width of 10 cm are subjected to 24 hours of electrolysis carried out at about 25°C with a direct current of 1.2 A by using an electrolytic cell composed of the porous membrane, a positive electrode, a negative electrode and diluted sulfuric acid.”

Since Choi fails to describe, teach, or suggest the claimed combination of features as set forth in claim 1, the anticipation rejection of claims 1 and 3-5 should be withdrawn and the obviousness rejection of claim 8 should be withdrawn. Since Tsuda fails to remedy the above-discussed deficiencies of Choi, the obviousness rejection of claims 6 and 7 should also be withdrawn.

In the event that this paper is not timely filed, applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,
KRATZ, QUINTOS & HANSON, LLP



Darren Crew
Attorney for Applicants
Reg. No. 37,806

DC/kn/ks

Atty. Docket No. **060623**

4th Floor

1420 K Street, N.W.

Washington, D.C. 20005

(202) 659-2930

23850

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